

REMARKS

In the Final Office Action mailed 21 September 2005, the examiner maintains the rejection of all claims. The rejections hinge on the examiner's assertion that functional language introduced with an "adapted to" clause does not constitute a patentable limitation. As discussed in further detail below, binding case law does not support the examiner's position.

Section 2111.04 of the MPEP explicitly acknowledges that "adapted to" claim language is not per se non-limiting. More particularly, the MPEP advises examiners that any argument made against "adapted to" claim language must be based on a "facts and circumstances" analysis. Adopting the position that the use of "adapted to" is always non-limiting, as the examiner does in the outstanding rejection, is erroneous and at odds with the explicit guidance given by the MPEP.

More pointedly, in 2001 the Board of Patent Appeals and Interferences overturned an examiner arguing that "adapted to" was never limiting. Ex Parte Ralph B. Brick, 2001 WL 1738852 (Bd. Pat. App. & Interf.) Remarkably, the language used by the examiner in the outstanding rejection against the instant application mirrors almost exactly the language of the rejection overturned by the Board in Brick. Specifically, the Brick examiner argued that "adapted to" means "able to perform" and that "it did not impart a limitation in any patentable sense." In supporting this argument, the Brick examiner cited In re Hutchinson, 33 C.C.P.A. 879, 154 F.2d 135, 69 U.S.P.Q. 138. In overturning the rejections, the Board in Brick stated (emphasis added):

The examiner's determination that claims 1 through 11 and 13 are indefinite for these reasons is not well taken. The "adapted to be" terminology in the claims constitutes functional language which merely defines the claimed packaging assembly elements in terms of what they are intended to do. Contrary to the position taken by the examiner, there is nothing intrinsically wrong with the use of this technique in drafting a patent claim.

Further, in 1976 the Court of Customs and Patent Appeals held that "adapted to" language as used in the claims at issue imposed definite, structural limitations by limiting the

recited structure to configurations that allow for the claimed functions to be performed. In re Venezia, 530 F.2d 956, 189 U.S.P.Q. 149 (C.C.A.P. 1976). Venezia has been cited by the District Courts and by the Federal Circuit for its “adapted to” holding, and Venezia remains good law today. See, e.g., Pac-Tec, Inc. v. Amerace Corp., 903 F.2d 796, 801, 14 U.S.P.Q.2d 1871 (Fed. Cir., 1990) (noted that “adapted to” constituted structural limitations); Elkay Mfg. Co. v. Ebco Mfg. Co., 192 F.3d 973, 979, 52 U.S.P.Q.2d 1109, (Fed. Cir. 1999) (noted that “adapted to fit on the upper portion” of a cabinet imparts a structural limitation to the removable mounting means); and Intel Corp. v. Via Technologies, Inc., 319 F.3d 1357, 1365-1366, U.S.P.Q.2d, (Fed. Cir., 2003) (noted that computer logic adapted to perform a function represents the corresponding structure for the functions recited).

The present invention describes a vehicle charger accessory for a mobile device, such as a cellular telephone, personal data assistant, etc. According to the present invention, the vehicle charger includes a first plug adapted to connect to the mobile device. A light source mounted or disposed on the first plug provides illumination while the user connects the plug to the mobile device. The applicant notes that each of the pending independent claims (claims 1, 8, and 16) claim a first plug adapted to connect to a mobile device. This language requires that the first plug be configured to connect to a mobile device. Further, independent claim 16 claims a second plug adapted to connect with the power supply of the vehicle. This language requires that the second plug be configured to connect to a vehicle power supply. As such, the “adapted to” language in the pending claims applies structural limitations to the claimed first and second plugs.

In light of the above remarks, it is clear that the examiner commits legal error by ignoring the “adapted to” limitations in the claims. Therefore, the applicant requests that the examiner reconsider the remarks presented in the previous response, which are repeated below for

convenience. Applicant notes that the previous response amended claim 1 to make it clear that the “adapted to” language applies to the first plug.

The Examiner rejects all pending claims of the present application as anticipated by or obvious in view of several references. As discussed further below, none of these references discloses or suggests the claimed invention and reconsideration is therefore respectfully requested.

First, the Examiner rejects independent claim 1 under §102(b) as anticipated by U.S. Patent No. 4,241,385 to Asano. Asano describes a car light, such as a large flashlight, having a detachable plug that fits within a cigarette lighter socket in a vehicle. As such, the light source taught by Asano receives power from a vehicle battery. However, the device in Asano is not a vehicle charger for a mobile device and does not have a first plug that is adapted to connect with a mobile device, as required by claim 1. Applicant respectfully requests reconsideration and withdrawal of this rejection.

Next, the Examiner rejects independent claim 16 and dependent claim 17 under §102(b) as anticipated by U.S. Patent No. 5,903,135 to Posses. Posses describes a vehicle charger for a mobile device having a digital recorder system and speaker phone. The Examiner asserts that plug 3 and terminal 4 of Posses correspond to the first and second plugs, respectively, of claim 16. The Examiner’s attempt to read claim 16 on Posses is disingenuous in that the Examiner ignores explicit functional limitation in the claims. Claim 16 states that the first plug “is adapted to connect with the mobile device,” and that the second plug “is adapted to connect with the power supply of a vehicle.” As described by Posses in column 3, lines 45 – 48 and shown in Figure 1, plug 3 of the vehicle charger connects to a cigarette lighter socket of a vehicle and thus corresponds to the second plug. Terminal 4 connects to a mobile device and corresponds to the first plug. However, terminal 4 (corresponding to the first plug) does not have a light source mounted thereon. Accordingly, Posses does not anticipate claims 17 and

17 because the requirement of a light source on the first plug (the one that connects with the mobile device) is not met.

The Examiner rejects claims 1- 6, 8 – 14, and 16 – 20 under §102(e) as anticipated by U.S. Patent No. 6,551,142 to Eisenbraun. Eisenbraun describes a vehicle charger 10 for an electronic device, including a mobile device. As shown in Figure 1, vehicle charger 10 includes plug 20 and plug 14 interconnected by cable 18. Plug 20 represents a plug adapted to connect to a mobile device, while plug 14 represents a plug adapted to connect to a cigarette lighter socket in a vehicle (Figure 1, column 3, lines 11 – 18, and column 4, lines 8 – 16). Further, Figure 3 shows that plug 14 includes two light sources 88 and 90. As such, Eisenbraun teaches that all light sources are disposed on the cigarette lighter plug 14, and not the electronic device plug 20.

As with Posses, the Examiner asserts that the cigarette lighter plug 14 of Eisenbraun corresponds to the first plug of the independent claims. However, independent claims 1, 8, and 16 explicitly require that the first plug be adapted to connect to a mobile device. Because Eisenbraun teaches that plug 14 is adapted to connect to a cigarette lighter and not to an electronic device, the Examiner's rejection is based on a flawed interpretation of Eisenbraun.

Each of the independent apparatus claims 8 and 16 require that the light source be part of the first plug and that the first plug is adapted to connect to a mobile device. Because the mobile device plug 20 taught by Eisenbraun does not include any type of light source, Eisenbraun cannot anticipate independent claim 8 or claim 16, or dependent claims 8 – 15 or 17 - 21. Further still, because Eisenbraun does not teach or suggest mounting a light source on a plug adapted to connect to the mobile device, Eisenbraun cannot anticipate independent claim 1 or dependent claims 2 - 7. Applicant respectfully requests reconsideration and withdrawal of this rejection.

Lastly, the Examiner rejects dependent claim 15 under §103 in view of Eisenbraun ('142) and also rejects dependent claim 21 under §103 in view of Eisenbraun ('142) and further in view of Eisenbraun (U.S. Patent 5,690,509). However, because independent claims 8 and 16 are patentable, as discussed above, these rejections are moot.

For at least the reasons presented above, Applicant asserts that claims 1 – 21 are patentably distinct from the cited art. As such, Applicant requests that the Examiner reconsider the rejections and allow the application to move forward to allowance.

Respectfully submitted,

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